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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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8

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/595,650

Applicant(s)

PANG, YUAN-PING

Examiner

Monika B. Sheinberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b)

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-54 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 sheets
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment PTO-948

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**DETAILED ACTION**

*Election/Restriction Response*

Claims 1-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 7, filed on May 17, 2001.

Applicant is hereby notified that the required timing for the correction of drawings has changed. See the last 6 lines on the sheet which is attached entitled "Attachment for PTO-948 (Rev. 03/01 or earlier)". It is noted that a PTO Form 948 was mailed with Paper No. 5 on February 26, 2001. Due to the above notification Applicant is required to submit drawing corrections within the time period set for responding to this Office action. Failure to respond to this requirement may result in abandonment of the instant application or a notice of a failure to fully respond to this Office action.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 37-54 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A simulated metal ion molecule does not accomplish a composition of matter, or material. As claimed, a simulation is only the manipulation of data that is representational of an idea or concept; and so a non-patentable subject matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the *first* paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37-54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in Ex parte Forman, 230 USPQ 546 (BPA 1986) and reiterated by the Court of Appeals in In re Wands, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a *prima facie* case are discussed below.

Claim 37 lacks a clear and concise recipe for parameter generation to obtain the claimed simulated metal ion. The specification as filed does not present a clear and direct explanation as to how the stated parameters are to be selected from a molecule to be used for designing simulated polyhedron-metalloprotein. Applicant is requested to point out in the instant

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application if there exists a disclosure of parameter selection and calculations. While working examples are not, per se, required, the specification must provide adequate guidance such that one of skill in the art could practice the invention without undue experimentation. Given the lack of working examples in the specification, and the unpredictability of parameter generation through X-ray crystallography in the context of a complex or simple molecule, the specification, as filed is not enabling for the generation of a simulated metal ion molecule for molecular dynamics simulation as claimed. As such, claims drawn to the use of simulated metal ion molecules are not enabled (claims 38-54).

The following is a quotation of the *second* paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 38, 39, and 44, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 38 and 39 are vague and indefinite in the manner that the mass of the recited dummy atom retain no units to describe the numerical value of "0.1". Therefore, it is unclear how the measurement of mass is defined.

In Claim 44, the term "main group" renders the claim indefinite because it is unclear as which elements are part of the claimed invention. The applicant is requested to define that which the applicant regards as his invention by group.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-49 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercandelli et al. (*J. Am. Chem. Soc.*, 1996) in view of Allinger et al. (*J. Mol. Struct. (Theochem)*, 1994).

Mercandelli et al. clearly motivates the simplification of molecular topology by using dummy atoms on page 111548 (2<sup>nd</sup> column, last paragraph). On page 11549, the reference states the setting of the metal atom parameters of the Van der Waals interactions to zero as recited in claim 37, line 4. Figure 1 (p. 11550) displays a model of a central metal ion and its evenly distributed interactions among dummy atoms: c, d and e. Mercandelli et al. references the use of all the parameters of transition metals, listed by Allinger et al. (Table 2, p. 75-77) as seen in claims 44-47 (p. 11549-11550, bridging sentence). As such, the reference motivates the claims 37 and 44-47 and all claims that are dependent upon the claims, or drawn to the use of the simulated metal ion molecule (claims 38-43, 48-49, and 52-54) are also motivated by the reference.

Claims 37-54, rejected under 35 U.S.C. 103(a) as being unpatentable over Mercandelli et al. in view of Allinger et al., as applied to claims 37-49 and 52-54 above, and further in view of Alberts et al. (*Protein Science*, 1998) and Stote et al. (*Proteins*, 1995).

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The dummy atom formalism within Mercandelli et al. prepares the basis of which the polyhedrons of Alberts et al. utilizes for setting ideal angles for different zinc coordination geometries with atoms at the apices in Figure 2, page 1704, as recited in claim 40. Figure 2 displays various polyhedrons as listed in claim 42, along with a metal ion, zinc, as the central metal ion as recited in claim 41, 43, and 45-47.

Stote et al. motivates the consideration of solvation energies on metal ions on page 17, Solution Simulation Results. These calculated energies of solvation are carried out on molecular models of metalloproteins, zinc in particular, utilized for simulations dynamic simulations as recited in claims 50 and 51. The calculations and experiments are clear and obvious to be used for the simulation described in claim 37 that Mercandelli et al. motivates, along with Alberts et al.

Mercandelli et al. in view of Allinger et al. suggests the basic invention; while Alberts et al. further describes the additional zinc-polyhedron, and Stote et al. further describes the solvation energy considerations in such inventions.

No claim is allowed.

#### ***Oath/Declaration***

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). A new oath or declaration is required.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

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in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242, or (703) 308-4028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monika B. Sheinberg, whose telephone number is (703) 306-0511. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703) 305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

August 8, 2001

Monika B. Sheinberg  
Patent Examiner  
Art Unit 1631

*MBS*

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER



w/ Pr No: 8  
09/595,650

**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

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